



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

0328

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/322,177	05/28/1999	HIROHIKO ITOH	35.G1549-CI	7620

5514 7590 12/05/2001

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

TRAN, DOUGLAS Q

ART UNIT	PAPER NUMBER
----------	--------------

2624

DATE MAILED: 12/05/2001

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/322,177

Applicant(s)

ITOH, HIROHIKO

Examiner

Douglas Q. Tran

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/28/99 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 05/28/99. It is noted, however, that applicant has not filed a certified copy of the said application as required by 35 U.S.C. 119(b).

2. Acknowledgment is made of applicant's claim for form PTO-1449 based on an application filed in Japan on 05/28/99. It is noted, however, the Examiner has not received a copy of the listed documents. the submission of those documents is required by the Examiner.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“ output means for outputting image data stored in said image storage means in an output mode, in accordance with output mode data stored on said storage medium by another apparatus, in correspondence with the image data, wherein said output means outputs the image data in an output mode corresponding to said output mode data, without any designation from said image processing apparatus.” renders the claim indefinite because it does not particularly point out or

Art Unit: 2624

distinctly claim how an output mode corresponding to the output mode data is stored on the detachable storage medium.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-2, 7-8, 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Yaguchi et al. (US Patent No. 5,579,419).

As to claim 1, Yaguchi teaches:

input means (i.e., the core portion 10 in fig. 1) for inputting image data;

image storage means (6 in fig. 1) for storing the image data input by the input means on a detachable storage medium (i.e., an optical magnetic memory; col. 12, lines 33-34 and 42-46);
and

output means (i.e., CPU 516 in fig. 6) for outputting image data stored in the image storage means (col. 13, lines 15-18) in an output mode (i.e., a command of retrieving/printing data), in accordance with output mode data stored on the storage medium (the coded data is stored in external storage device 6, col. 12, 56-58 and col. 13, lines 10-12) by another apparatus (i.e., reader portion 1 or pc/ws in fig. 1, col. 15, lines 7-13) , in correspondence with the image data,

wherein the output means outputs the image data in an output mode corresponding to the output mode data, without any designation from the image processing apparatus (note: a command comes from the reader 1 or pc, not in 3 in fig. 1).

Art Unit: 2624

As to claim 2, Yaguchi teaches:

the output means outputs the image data, in which the output mode data is stored, out of the image data stored on the storage medium, in accordance with the output mode (col. 13-18).

As to claim 7, Yaguchi teaches:

detection means (i.e., CPU 516) for detecting whether a detachable storage medium (6 in fig. 1, col. 13, lines 13-17), on which image data and output mode data corresponding to the image data are stored, has been loaded; and

output means (i.e., CPU 516 in fig. 6) for outputting image data corresponding to the output mode data stored on the storage medium (col. 13, lines 15-18) in an output mode (i.e., a command of retrieving/printing data) corresponding to the output mode data when the detection means detects the storage medium has been loaded (the coded data is stored in external storage device 6, col. 12, 56-58 and col. 13, lines 10-12).

As to claim 8, Yaguchi teaches the output mode data is stored on the storage medium by another apparatus (col. 13, lines 10-12 or reader portion 1 or pc/ws in fig. 1, col. 15, lines 7-13).

As to claim 13, Yaguchi teaches the method is performed by apparatus claim 1 as indicated above.

As to claim 14, Yaguchi teaches storing a plurality of files of image data in step (a) and storing different output mode data for different files in step (b) (col. 19, lines 29-31).

As to claim 15, Yaguchi teaches a step for storing information regarding whether the output in step (d) has been executed (col. 13, lines 13-18).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-6, 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaguchi et al.

As to claims 3-6, Yaguchi teaches the limitations in claim 1 above.

Yaguchi does not teach output mode data including a number of copies or pages, output size, both sides of a sheet, a sorted form and stapled form which is well known in the prior art.

It would have been obvious to have modified the printing command in the printing system of Yaguchi in order to include the options of the printing commands. The suggestion for modifying the system of Yaguchi can be reasoned by one of ordinary skill in the art because such a modifying system including the options for printing command would give the user a flexible choice for printing the document.

As to claims 9-12, due to the similarities of these claims to those of claims 3-6, these claims are rejected as the reason applied in claims 3-6.

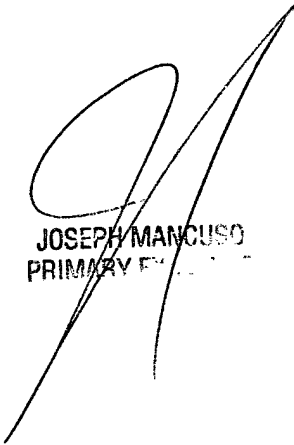
Art Unit: 2624

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran
Dec. 01, 2001



JOSEPH MANCUSO
PRIMARY EXAMINER